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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,635	09/29/2004	Eberhard Ammermann	53404	4301
26474 7590 04/29/2009 NOVAK DRUCE DELUCA + QUIGG LLP 1300 EYE STREET NW SUITE 1000 WEST TOWER WASHINGTON, DC 20005				
EXAMINER SULLIVAN, DANIELLE D				
ART UNIT		PAPER NUMBER		
1616				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/509,635

**Applicant(s)**

AMMERMAN ET AL.

**Examiner**

DANIELLE SULLIVAN

**Art Unit**

1616

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-6 and 16-30 is/are pending in the application.
- 4a) Of the above claim(s) 4, 5, 18, 22 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 16, 17, 19-21, 23-25 and 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/25/2008 has been entered.

### ***Election/Restrictions***

Applicant's election with traverse of the election of a single compound of Formula I a) (pyraclostrobin) and a single crop protectant b) [3-(4,5-dihydroisoxazol-e-yl)-methanesulfonyl-2-methylphenyl]-(5-hydroxy-1-methyl-1H-pyrazole-4-yl) a compound of Formula IX, in the reply filed on 1/12/2009 is acknowledged. The traversal is on the ground(s) that the present application is a national stage entry of a PCT and that lack of unity requires consideration of the claimed invention as a whole and does not provide a basis to require election of a single species of either Formula I or a single crop protection product. This is not found persuasive because the compounds encompassed by formula I include different functional groups disclosed in claim 17 are independent and distinct species. Furthermore, 37 C.F.R. 1.141 is herein recited below:

**§ 1.141 Different inventions in one national application.**

- (a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

Several structures of Formula I are claimed thereby requiring and election of species to be made in order to not exceed a reasonable number of structures to be searched. The requirement is still deemed proper and is therefore made FINAL.

Claims 4, 2, 18, 22 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/12/2009.

Claims 4-6 and 16-30 are pending. Claims 6, 16, 17, 19-21, 23-25 and 27-30 are under examination. Claims 4, 5, 18, 22 and 26 withdrawn as being drawn to a nonelected species.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 recites "the herbicidal crop protection product is applied to the seeds in an amount of from 0.001 to 0.1 g/kg". This is indefinite because while the specification details an amount of 0.001 to 0.1 g, per kilogram of seed the present recitation fails to show what the range is relative to (weight of seed).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 16, 17, 19-21, 23-25 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller et al. (US 6,159,992) in view of Deyn et al. (US 2002/0025910).

### **Applicant's Invention**

Applicant claims a method for increasing the resistance of plants to phytotoxicity, comprising treating the plant, soil or seeds with pyraclostrobin applied with [3-(4,5-dihydroisoxazol-e-yl)-methanesulfonyl-2-methylphenyl]-(5-hydroxy-1-methyl-1H—yrazole-4-yl). Claim 20 specifies the subterranean parts of the plants (soil/seed) are treated. Claim 23 specifies the plants treated include wheat, barley, rye, oats, rice, turf,

maize, bananas, cotton, soya, coffee, grapevines, fruits, ornamentals and vegetables.

Claim 29 specifies the combination is applied to the plants or soil in an amount of from 0.1 to 2 kg/ha. Claim 30 specifies the amount applied to seeds is 0.001 to 0.1 g/kg.

**Determination of the scope and the content of the prior art**

**(MPEP 2141.01)**

Muller et al. teach fungicidal mixtures comprising a carbamate of formula I which encompasses pyraclostrobin (abstract; Formula I.32). It is preferred that further active ingredients are admixed that are herbicidal (column 3, lines 5-10). The plants treated include grass, oats, cotton bananas, coffee, maize, fruit, rice, soya, grapevines, wheat, ornamentals, rye barley and a variety of seeds (column 3, lines 19-24). Application rates range from 0.01 to 8 kg/ha and for seed treatments the range is from 0.001 to 250g/kg of seed (column 3, lines 52-64). The compounds are applied against fungi to the plants, soil or seeds (column 4, lines 56-60).

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Muller et al. do not teach that pyraclostrobin is applied in combination with [3-(4,5-dihydroisoxazol-e-yl)-methanesulfonyl-2-methylphenyl]-(5-hydroxy-1-methyl-1H—yrazole-4-yl). It is for this reason that Deyn et al. is joined.

Deyn et al. teach 3-heterocyclyl-substituted benzoyl derivatives in by formula IX, including [3-(4,5-dihydroisoxazol-e-yl)-methanesulfonyl-2-methylphenyl]-(5-hydroxy-1-methyl-1H—yrazole-4-yl) (abstract; column 27, lines 16-30). The compounds have herbicidal activity (column 2, lines 47-49; column 123, lines 35-45). Application rates

range from 0.001 to 3 kg/ha (column 126, lines 55-59). To widen the spectrum of action and to achieve synergy the 3-heterocycl-yl-substituted benzoyl derivatives can be mixed and applied to other herbicides or growth-regulatory active ingredients (column 126, lines 60-64). However, it is advantageous to combine the compounds with additional crop protection agents, including those used for controlling phytopathogenic fungi with non-phytotoxic oils (column 127, lines 20-29).

### **Finding of prima facie obviousness**

#### **Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Muller et al. and Deyn et al. to utilize a combination of pyraclostrobin and [3-(4,5-dihydroisoxazol-e-yl)-methanesulfonyl-2-methylphenyl]-(5-hydroxy-1-methyl-1H—yrazole-4-yl). One would have been motivated to combine the two ingredients because Deyn et al. teach that [3-(4,5-dihydroisoxazol-e-yl)-methanesulfonyl-2-methylphenyl]-(5-hydroxy-1-methyl-1H—yrazole-4-yl) is advantageously combined with fungicides and that non-phytotoxicity is important in formulating the end product. Furthermore, Muller et al. teach that pyraclostrobin is preferably applied with other ingredients that are herbicidally active. Hence, one of ordinary skill in the art would have been lead to combined pyraclostrobin with [3-(4,5-dihydroisoxazol-e-yl)-methanesulfonyl-2-methylphenyl]-(5-hydroxy-1-methyl-1H—yrazole-4-yl) in order to achieve a composition which reduces phytotoxicity and has dual action as an herbicide and a fungicide .

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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